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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/720,825
Filing Date: November 24, 2003
Appellant(s): REDING ET AL.

John E. Harrity
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/12/2008 appealing from the Office action mailed 08/14/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | |
|----------|-----------------|
| Karve | US 2002/0137530 |
| Packham | US 2003/0055906 |
| Gopinath | US 2004/0002350 |
| Dehlin | US 2004/0203942 |
| Sabo | US 2004/0203942 |
| Fostick | US 2002/0187794 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I) Claims 1, 2, 6, 9, 10, 12, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karve (US-2002/0137530; previously cited) in view of Packham (US-2003/0055906).

Regarding claim 1, Karve discloses a method for providing SMS messages (fig. 3 and its description) to a receiving party (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]), the method comprising:

- receiving a SMS message for a first device (“telephone 10”) of the plurality of devices ([0028]-[0029]);

- identifying a second device of the plurality of devices as a preferred device (“a predefined number” [0032]-[0035]) for receiving the SMS message based on information stored by the receiving party ([0032]-[0035]);

- formatting the SMS message according to characteristics of the preferred device [0028]; and

- sending the formatted message to the preferred device ([0008]-[0010] and [0032]-[0035]).

But, Karve does not particularly show instead of the first device for receiving the SMS message. However in analogous art, Packham teaches instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to “turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their

messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day” (see [0019]-[0022]).

Regarding claim 2, Karve further discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to a SMS-capable device ([0008] and [0028]).

Regarding claim 6, Karve further discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to digital companion client software (described as “the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center” see [0033]).

Regarding claim 9, Karve discloses an apparatus (fig. 2 and description) for providing SMS messages to a user (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]), comprising:

a database (“a memory at the SMS center” see [0033]) for storing information identifying each device of the plurality of devices (described as “identifying a pointer to a multiple destination address stored in a memory at the SMS center” see [0033]) and

identifying a first device of the plurality of devices as a preferred device (described as “with the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center” see [0033]);

a gateway server (“SMS center” see [0028]) for receiving a SMS message
identifying a second device (“telephone 10”, see [0029]) of the plurality of devices (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]);

a server function for identifying the preferred device in response to receiving the SMS message [0033], the preferred device being different than the second device (two different devices); and

a SMS server for sending the SMS message to the preferred device ([0033]-[0035]), the SMS server being further configured to format the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0008]-[0010] and [0028]-[0040]).

But, Karve does not particularly show instead of the second device for receiving the SMS message. However in analogous art, Packham teaches instead of the second for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to “turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their

messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day” see [0019]-[0022).

Regarding claim 10, Karve further discloses the apparatus of claim 9, wherein the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]).

Regarding claim 12, Karve discloses an apparatus for providing SMS messages to a user (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]), comprising:

means for storing a specification of a preferred device (“a predefined number” [0032]-[0035]);

means for receiving a SMS message identifying one device (“telephone 10”, see [0029]) of the plurality of devices [0028];

means for selecting the preferred device in response to receiving the SMS message ([0027]-[0035]), the preferred device being different than the identified one device (two different devices); and

means for sending the SMS message to the preferred device ([0032]-[0035]), the means for sending the SMS message comprises means for formatting the SMS

message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0008]-[0010] and [0028]-[0040]).

But, Karve does not particularly show instead of the identified one device for receiving the SMS message. However in analogous art, Packham teaches instead of the identified one device for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to “turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day” see [0019]-[0022).

Regarding claim 13, Karve further discloses the apparatus of claim 12, wherein the means for sending the SMS message comprises means for storing messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]).

Regarding claim 16, Karve discloses a method (fig. 3 and its description), comprising:

receiving a SMS message [0028] including information identifying a first destination device (“telephone 10”, see [0029]);

identifying a second destination device (“a predefined number” [0032]-[0035]) in response to receiving the SMS message, the second destination device being different than the first destination device (two different devices);

formatting the SMS message based on the second destination device [0028];
and

sending the formatted SMS message to the second destination device ([0032]-[0035]).

But, Karve does not particularly show instead of the first destination device for receiving the SMS message. However in analogous art, Packham teaches instead of the first destination device for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to “turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day” see [0019]-[0022].

Regarding claim 17, Karve further discloses the method of claim 16 wherein the first destination device and the second destination device (interpreted as “forwarding a received short message from the telephone 10 to another device or telephone” see [0029]) are associated, able to communicate, with a receiving party (owner of telephone 10, [0029]), and wherein the identifying includes: identifying the second destination device based on a profile associated with receiving party ([0032]-[0033]).

II) Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Packham and further in view of Gopinath (US-2004/0002350).

Regarding claim 3, Karve and Packham discloses the method of claim 1. Both Karve ([0008]) and Packham ([0022]) suggest sending the formatted message to a personal computer and the user is able to retrieve the message. But Karve and Packham do not particularly teach wherein sending the formatted message comprises sending the formatted message to an e-mail address. However in analogous art, Gopinath teaches wherein sending the formatted message comprises sending the formatted message to an e-mail address ([0054]-[0069]). Since, Karve, Packham and Gopinath are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Gopinath for purpose of incorporating the internet system with the SMS message system for increasing advantageously the communication services to the users.

III) Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Packham and further in view of Dehlin (US-2004/0203942; previously cited).

Regarding claim 4, Karve and Packham disclose the method of claim 1 except wherein sending the formatted message comprises sending the formatted message to an instant messenger client. However in analogous art, Dehlin teaches wherein sending the formatted message comprises sending the formatted message to an instant messenger client (described as “The reply customized SMS message is translated into a reply instant message” or “SMS message has been identified as an instant message type” see abstract and [0026]). Since Karve, Packham and Dehlin are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Dehlin for purpose of “enabling instant messaging on a mobile device” (see Dehlin’s title and specification).

IV) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Sabo (US-2003/0096626; previously cited).

Regarding claim 5, Karve and Packham disclose the method of claim 1 except wherein sending the formatted message comprises sending the formatted message as a voice message to a phone. However in analogous art, Sabo teaches wherein sending the formatted message comprises sending the formatted message as a voice message to a phone (described as “SMSC 18 translates the secure SMS message to a voice message, using a text-to-speech translator 24 comprised in the SMSC, and transmits

text message 38 as a voice message 40” see [0031]. Since Karve, Packham and Sabo are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Sabo for purpose of “in the case of the landline telephone, the translation is preferably to speech in a text-to-speech converter associated with the SMSC” (see Sabo’s specification, para. [0013]).

V) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Packham and further in view of Fostick (US-2002/0187794).

Regarding claim 7, Karve further discloses the method of claim 1 that once the mobile device receives a SMS message, which can be immediately displayed on the display of the mobile device. In either case, the message is stored for when the user desires to read the message. But Karve and Packham do not particularly teach storing messages in a database when the preferred device is not available to receive messages. However in analogous art, Fostick teaches wherein storing messages in a database when the device is not available to receive messages [0007]. Since, Karve, Packham and Fostick are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Fostick for purpose of guaranteeing the message delivery.

(10) Response to Argument

A) Appellant's arguments, with respect to the rejection of claims 1, 2, 6, 9, 10, 12, 13, 16, and 17 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530) and PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), have been fully considered and are deemed not persuasive for following reasons.

I) Respect to the rejection of claims 1, 2 and 6:

a) Appellant argued that KARVE and PACKHAM et al. do not disclose or suggest identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party. The examiner respectfully disagrees with the appellant's argument. Karve clearly shows in figure 3 that his mobile communication device is able to receive a SMS message (step 30) and forward it to the plurality of devices (step 46 and [0035]). Karve specifically describes in paragraph [0035] that his mobile communication device can automatically forward the SMS message to a predefined number which is stored and defined by the owner of the mobile communication device that reads on the claimed limitation "identifying a second device of the plurality of devices as a preferred device for receiving the SMS message based on information stored by the receiving party". It is appeared that Karve does not particularly disclose identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party, or more specifically that Karve does not expressly teach instead of the first device for receiving the SMS

message. However in analogous art, Packham teaches the missing feature of claimed limitation from Karve as shown in figure 1, that the preferred device (fig. 1, 3) could receive the forwarding SMS message directly from the sender (fig. 1, 2) instead of the first device (fig. 1, 2) [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to “turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day” (see [0019]-[0022]). Consequently, Karve and Packham disclose the claimed limitation “identifying a second device of the plurality of devices as a preferred device instead of the first device for receiving the SMS message based on information stored by the receiving party”.

b) Appellant argued that “the system of KARVE were modified to incorporate the teachings of PACKHAM et al., such a combination would result in a system that forwards text messages away from KARVE's cellular telephone before they reach the telephone, which would render KARVE's system (which is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device) inoperable... one skilled in the art would not reasonably look to incorporate PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding

information and a SMS/GMSC that forwards text messages intended for a first device to a second device into the KARVE system since the KARVE system is directed to actions performed by a cellular device (the first device). If one were to incorporate PACKHAM et al.'s HLR and SMS/GMSC into the KARVE system, this combination would obviate the need for the KARVE invention since the forwarded destination of the text message is identified prior to reaching the first device (KARVE's cellular device)... KARVE is directed to a cellular telephone that receives an SMS message and forwards the SMS message to another number or device (see, for example, Abstract). If, as the Examiner alleges, a user turns off KARVE's cellular telephone, KARVE's system becomes meaningless". The examiner respectfully disagrees with the appellant's argument. Since, both Karve's system ([0002] and [0024]) and Packham's system ([0002] and [0019]) are the same as a mobile telecommunication system, or more specifically they both are concerned about the forwarding SMS message to the mobile phone; one or ordinary skill in the art can understand that the mobile telecommunication system must use the HLR (Home Location Registration) to determine the location of the mobile phone before the SMS message can be forwarded. Furthermore, both Karve ([0002] and [0024]) and Packham ([0002] and [0019]) systems support SMS center for providing SMS service to the mobile phones (see Karve [0007] and Packham [0021]); and, both Karve [0035] and Packham ("menu" see [0020]) mobile phones (claimed "first device") can allow the user to select the preferred device (claimed "second device") for receiving the forwarding SMS message. The only difference is that Karve does not particularly describe the second device is able to receive the forwarding message

instead of the first device, while Packham particularly discloses that the second device is able to receive the forwarding message instead of the first device for such a case that the second device can receive the SMS message for both devices [0021] or in another case the first device is turned off [0022] after the preferred device is selected [0020].

The ordinary skilled artisan would see that it is not necessary for the first device of Packham must turn off in order for the second device to receive the forwarding SMS message; or even the case the first device is turn off, the user already selected the second device which is preferred device for receiving the forwarding SMS message.

Therefore, one of ordinary skill would have readily recognized that by incorporating the teaching of Packham into Karve mobile telecommunication system, users of that system who “have two phones to receive all their text messages on one, which saves people with two handsets needing to carry them both about” (see Packham [0021]) or “the user would be able to turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages” (see Packham [0022]). Thus, the system of KARVE were modified to incorporate the teachings of PACKHAM, which would render KARVE's system operable.

Since, the first criteria of the prior art references teaching or suggesting all the claim limitations was met (see section (a) above). The second criteria of a reasonable expectation of success was met as both references are from a similar field of endeavor, and the combination of the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success (see section (b) above). The third criteria of motivation was met by providing a

motivation from the secondary reference. Consequently, a prima facie case of obviousness under 35 U.S.C. 103 has been established.

With all the reasons stated above, the rejection of claim 1 is deemed proper. Since, claims 2 and 6 depend from claim 1; therefore, the rejection of claims 2 and 6 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM still stands.

II) Respect to the rejection of claim 9:

Appellant argued that “KARVE and PACKHAM et al. do not disclose or suggest a database for storing information identifying each device of the plurality of devices and identifying a first device of the plurality of devices as a preferred device”. The examiner respectfully disagrees with the appellant’s argument. Karve discloses in paragraph [0035] that the user of a mobile communication device can select a predefined number (or numbers) which is (are) stored at the SMS center (“address lists stored at the SMS center” [0033] reads on claimed limitation “a database for storing information identifying each device of the plurality of devices”) Since, Karve discloses that “short messages are not sent directly from sender to recipient, but always via an SMS Center” and a predefined number (reading on claimed “a first device”) is selected by the user from a plurality of numbers (fig. 3 and [0035]) as a preferred device in order for the SMS center to forward the message; one of ordinary skill in the art could see that the SMS center must identify the first device before the message is forwarded to the first device. Thus, Karve discloses the claimed limitation “a database for storing information identifying

each device of the plurality of devices and identifying a first device of the plurality of devices as a preferred device”.

It is noted that the terms “first device” and “second device” of claim 9 are reversely used in claim 1. The explanation of the rejection of claim 1 in the section (I) can be applied for the appellant's argument of claim 9.

III) Respect to the rejection of claim 10:

Appellant argued that Karve does not disclose the claimed limitation “wherein the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages”. Karve discloses that the recipient of the mobile phone can select a preferred device for receiving the forwarding SMS message [0035] and paragraph [0007] of Karve specifically describes that “SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages”. It is reasonably interpreted that the SMS center must store the SMS message which is sent from the sender before the SMS message is forwarded to the recipient's preferred device. Since, Karve discloses the preferred device can receive the forwarding SMS message when it is not available to receive the voice message [0011] and claimed limitations are not expressly distinguished the first appearance of “messages” and the second appearance “messages”, therefore Karve discloses the claimed limitation

“wherein the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages”.

It is noted that the examiner relies upon reference, as a whole, to anticipate the instant claims. Reference’s specific citations are to pinpoint pertinent passages to aid in the understandings of the reference as applied to the particular claimed elements.

IV) Respect to the rejection of claim 12:

Appellant argued that “KARVE and PACKHAM et al. do not disclose or suggest means for selecting the preferred device instead of the identified one device for receiving the SMS message in response to receiving the SMS message, the preferred device being different than the identified one device”. The examiner respectfully disagrees with the appellant’s argument. Karve discloses in paragraph [0035] that the mobile communication device (reading on claimed “identified one device”) can allow user to select a predefined device (reading on claimed “preferred device” and “the preferred device being different than the identified one device”) for receiving the forwarding SMS message. The explanation of the rejection of claim 1 in the section (I) can be applied for the missing claimed feature “instead of the identified one device” and every appellant's argument of claim 12.

V) Respect to the rejection of claim 13:

The explanation of the rejection of claim 10 in the section (IV) can be applied for the appellant's argument of claim 13.

VI) Respect to the rejection of claims 16 and 17:

The explanation of the rejection of claim 1 in the section (I) can be applied for the appellant's argument of claim 16.

The rejection of claim 16 is deemed proper. Since, claim 17 depends from claim 16; therefore, the rejection of claim 17 under 35 U.S.C. § 103(a) based on KARVE and PACKHAM still stands.

B) In response to the appellant's argument, with regard to the rejection of claims 3, under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and GOPINATH et al. (U.S. Patent Application Publication No. 2004/0002350), it is believed that Karve and Packham disclose all the limitations of the independent claims (see section (I) above) from which claim 3 depends. Thus, the combination of Karve, Packham and GOPINATH can be used to establish prima facie obviousness for claim 3 because the references teach or suggest all claim limitations as required. See MPEP § 2143.03. Therefore, prima facie obviousness under 35 U.S.C. § 103 has been established.

C) In response to the appellant's argument, with regard to the rejection of claims 4, under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No.

2003/0055906), and Dehlin et al. (U.S. Patent Application Publication No. 2004/0203942), it is believed that Karve and Packham disclose all the limitations of the independent claims (see section (I) above) from which claim 4 depends. Thus, the combination of Karve, Packham and Dehlin (Dehlin teaches wherein sending the formatted message comprises sending the formatted message to an instant messenger client (described as “The reply customized SMS message is translated into a reply instant message” or “SMS message has been identified as an instant message type” see abstract and [0026]) can be used to establish prima facie obviousness for claim 4 because the references teach or suggest all claim limitations as required. See MPEP § 2143.03. Therefore, prima facie obviousness under 35 U.S.C. § 103 has been established.

Appellant argue that “this section of DEHLIN cannot disclose or suggest that sending the formatted message to a preferred device (which is identified, instead of a first device, for receiving the SMS message)”, the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this particular case, Karve and Packham were used to teach all claimed limitation of claim 1 except the claimed limitation of claim 4. Further, Dehlin was used to teach the claimed limitation of “wherein sending the formatted message comprises sending the formatted message to an instant messenger client” (described as “The reply customized SMS message is translated into a reply instant message” or “SMS message has been

identified as an instant message type” see abstract and [0026]). Therefore, the examiner asserted that it would be obvious to one of ordinary skill in the art to apply Dehlin’s teaching in method of Karve and Packham for purpose of “enabling instant messaging on a mobile device” (see Dehlin’s title, abstract and [0026]).

D) In response to the appellant’s argument, with regard to the rejection of claims 5, under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and Sabo et al. (U.S. Patent Application Publication No. 2003/0096626), it is believed that Karve and Packham disclose all the limitations of the independent claims (see section (I) above) from which claim 5 depends. Thus, the combination of Karve, Packham and Sabo (Sabo teaches wherein sending the formatted message comprises sending the formatted message as a voice message to a phone (described as “SMSC 18 translates the secure SMS message to a voice message, using a text-to-speech translator 24 comprised in the SMSC, and transmits text message 38 as a voice message 40” see [0031]) can be used to establish prima facie obviousness for claim 5 because the references teach or suggest all claim limitations as required. See MPEP § 2143.03. Therefore, prima facie obviousness under 35 U.S.C. § 103 has been established.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

E) In response to the appellant's argument, with regard to the rejection of claims 7 under 35 U.S.C. § 103(a) based on KARVE (U.S. Patent Application Publication No. 2002/0137530), PACKHAM et al. (U.S. Patent Application Publication No. 2003/0055906), and Fostick et al. (U.S. Patent Application Publication No. 2002/0187794), it is believed that Karve and Packham disclose all the limitations of the independent claims (see section (I) above) from which claim 7 depends. Thus, the combination of Karve, Packham and GOPINATH can be used to establish prima facie obviousness for claim 7 because the references teach or suggest all claim limitations as required. See MPEP § 2143.03. Therefore, prima facie obviousness under 35 U.S.C. § 103 has been established.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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(12) Conclusion

For the above reasons, it is believed that the rejection is proper, and the Board of Patent Appeals and Interferences is therefore respectfully urged to sustain the Examiner's rejection.

Respectfully submitted,

/Huy Q Phan/
Examiner, Art Unit 2617
06/30/2008

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